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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,208	02/27/2002	Edgardo Laborde	25352-0031	7485

25213 7590 11/26/2003

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EXAMINER	
FORD, JOHN M	

ART UNIT	PAPER NUMBER
1624	

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/087,208	LABORDE ET AL.	
	Examiner	Art Unit	
	John M Ford	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1--52 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1--52 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

The claims in the application are claims 1—52.

Rule 141 provides for one invention per application.

There is far more here than can be examined in one application.

Applicants need to pick one set of compounds by electing one value of X, one value of Y, and one value of Z. Once that is done for claims 1—35, the claims need be re-written to the invention elected, it is too burdensome for the examiner to examine more here.

MPEP 806.05(h) provides for restricting the method claims out, if it can be established that the compounds may be used for more than one purpose.

Therefore, claims 38-50 and 52 are placed in a different group as they allege more than one use of the compounds.

Claims 37 and 51 have additional active ingredients.

The agreement to examine a supportable method of use with the elected compounds is based on their being of the same scope. Once an unknown additional active ingredient is introduced, the classification and search changes, and greatly increases the burden on the examiner.

Once an additional active ingredient is introduced, the method claim is no longer of the same scope as the agreed upon elected compound claim.

Therefore, claims 37 and 51 are restricted out as an egregious burden.

This application has been found to contain more than one invention. Therefore, restriction to one of the following distinct inventions is required:

(I) Claims 1—35 drawn to compounds with a variable X, Y and Z, which place the compounds in many, many subclasses in class 544 and class 546. An election of a specific X, a specific Y and a specific Z is required. There is no way to begin, without at least that much. There is too much here, (See 37 CFR 1.104).

(II) Claims 36, 38 — 50 and 52 drawn a composition and multiple methods of use in many, many, different subclasses of class 514, depending on what X, Y and Z, are, specifically. Claim 36 and a supportable method elected from claims 38—50 and 52 will be allowed, if it is the same scope as the allowable genus, once an elected compound genus is found allowable. Applicants need to elect something believable that does not require considerable proof. Claim 47 is suggested.

(III) Claims 37 and 51 drawn to unknown additional active ingredient claims, of unknown classification, as the unknown additional active ingredient is not specified.

These distinct inventions have acquired separate status in the art, will support separate patents, and will require different fields of search for the respective inventions. Accordingly, restriction for examination purposes, as indicated, is considered proper; 35 U.S.C. 121; 37 CFR 1.141 and 37 CFR 1.142.

Claim 1 constitutes an improper joinder of inventions as it group's together distinct specific inventions that are distinct and separately classified, and will support separate patents. Ex parte Markush, 1925 C.D. 126, provided for this

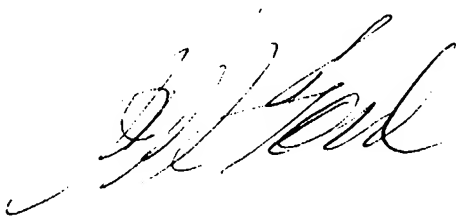
claim structure where there was an emergency engendered need, as the substances were "so closely related that they would not support a series of patents". This is not the case here. Therefore, the instant generic claim constitutes an improper joinder of inventions; Ex parte Reid, 105 U.S.P.Q. 251; In re Winnek, 73 U.S.P.Q. 225; In re Ruzicka, 66 U.S.P.Q. 226.

This application has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is, therefore, requested in promptly correcting any errors of which they may become aware in the specification.

Applicants' response must include a provisional election, even if the requirement be traversed, see 37 CFR 1.143 and 37 CFR 1.144.

John M. Ford:jmr

November 21, 2003



JOHN M. FORD
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